

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 19 is requested to be cancelled without prejudice or disclaimer.

Claims 20, 25, 30, 32, 37, 41 and 44 are currently being amended. Support for these amendments can be found at least in FIGS. 14-19 and the accompanying description which illustrate the print button 254, and in FIG. 9, particularly steps S42 and S43. No new matter is being added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 20-47 are now pending in this application.

Information Disclosure Statement

Applicants respectfully request that the Examiner consider references A12 to A18 listed on the Form PTO/SB/08 submitted with the Information Disclosure Statement ("IDS") filed on March 25, 2004. As noted in the IDS, the documents listed were cited or submitted to the U.S. PTO in parent application Serial No. 09/321,828, filed 05/28/1999. As provided in 37 CFR §1.98(d), copies of the documents were not provided with the IDS since they were previously submitted to the United States Patent & Trademark Office in the above-identified parent application. Applicants respectfully request that listed documents A12 to A18 be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

Double Patenting

Claim 19 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,724,492 (“492 patent”). This rejection is moot in light of the cancellation of claim 19.

Rejections under 35 U.S.C. §§ 102 and 103

Claims 19-20, 22-28, 30-32, 34-40 and 42-47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,222,157 to Yoneda et al. (“Yoneda”). Claims 21, 29, 33 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoneda in view of well known prior art. Applicants respectfully traverse these rejections for at least the following reasons.

Independent claim 20, as amended, recites:

An image forming system comprising:

a control panel including a first touch screen menu including a trial printing button configured to, when user selected, initiate a trial preceding print of a page of image data without an additional user selection, and a printing button configured to, when selected by a user, initiate printing of all pages of the image data in response to the selection of the printing button;

a printer that performs the trial preceding print by printing the page of image data in response to the selection of the trial printing button and performs the printing of all pages of the image data;

a controller that sets a desired specification according to operation of the control panel after the printer performs the trial preceding print, and deletes the image data after the printing of all pages;

wherein the printer prints all pages of the image data or the page of the image data according to the desired specification set by the controller.

Thus, the control panel of the apparatus of claim 20 includes both a trial printing button and a printing button, where when the print button is pressed, all pages of image data are printed by the printer, and after printing all pages, the image data is then deleted. This feature of claim 20 has the benefit that as a result of this image data deletion following printing, sufficient memory capacity can be secured after printing. Thereby, it is possible to perform the succeeding image formation processing rapidly and reliably. Yoneda neither

discloses the above mentioned features of claim 20, nor suggests the benefits attendant thereto.

Yoneda merely discloses that all or part of a document can be selected to be printed out (FIG. 12, col. 17, line 64 – col. 18, line 4). In contrast to claim 1, however, Yoneda does not disclose both a trial printing button and a printing button, where when the print button is pressed, all pages of image data are printed by the printer, and after printing all pages, the image data is then deleted. While Yoneda discloses selecting all pages and printing them, Yoneda does not disclose deleting the image data for the pages after the printing.

Moreover, Yoneda does not suggest the benefits of the combination of features of claim 20, where as a result of the image data deletion after printing all the pages, sufficient memory capacity can be secured after printing. In the system of Yoneda where the image data is not disclosed as being deleted after printing all of the pages, it is not possible to perform succeeding image formation processing rapidly and reliably in the manner of the apparatus of claim 20.

Independent claims 25, 30, 32, 37, 41 and 44 have been amended in a manner similar to the amendments made to claim 20, and are patentable for analogous reasons.

The dependent claims are patentable for at least the same reasons as their respective independent claims, as well as for further patentable features recited therein.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,

otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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